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RECORD OF ORAL HEARING
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NOBUYUKI TAKAMORI,
HIDEHARU TAJIMA,
and AKIRA TAKAHASHI

Appeal 2008-2231
Application 10/002,949
Technology Center 1700

Oral Hearing Held: September 10, 2008

Before BRADLEY R. GARRIS, PETER F. KRATZ, and
JEFFREY T. SMITH, Administrative Patent Judges

ON BEHALF OF THE APPELLANT:

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1 The above-entitled matter came on for hearing on Wednesday,
2 September 10, 2008, commencing at 9:25 a.m., at the U.S. Patent &
3 Trademark Office, 600 Dulany Street, Ninth Floor, Alexandria, Virginia,
4 before Christine L. Loeser, Notary Public.

5 MR. RUSSETT: Good morning.

6 JUDGE GARRIS: Good morning, Mr. Russett. Welcome to
7 the board.

8 MR. RUSSETT: Thank you.

9 JUDGE GARRIS: You know you have 20 minutes. Please
10 begin.

11 MR. RUSSETT: Thank you. This is my first time before the
12 board, actually, so I'm not sure exactly how you prefer to do things.

13 JUDGE GARRIS: Well, welcome to the board. We wish you
14 luck today.

15 As I mentioned earlier, you do have 20 minutes to present your
16 case. We have reviewed the record. We are familiar with your claimed
17 invention, the prior art that's been applied and the rejection the examiner has
18 made.

19 So if you would care to go ahead and present your arguments
20 with respect to these rejections, we'll ask questions as we feel a need to.

21 MR. RUSSETT: Okay. If I'm repeating things too much,
22 please stop me and I'll move on.

23 Since you are familiar with the record, you know that there are
24 basically two classes of rejections. There are the anticipation rejections
25 under 102 for three cited references and there are some obviousness
26 rejections as well.

1 The anticipation rejections all suffer from common flaw. The
2 examiner is attempting to make a case for inherency but hasn't provided any
3 evidence whatsoever that the properties that are alleged to be inherent in the
4 materials that are shown in those references are actually there.

5 This, of course, has been the subject of much back and forth in
6 the record to this point, but the examiner has never said anything more than
7 that he asserts that these things are inherent in the face of whatever evidence
8 the appellants have proffered.

9 The examiner agrees that those properties are not shown
10 anywhere in the references, and the references don't discuss these properties.
11 They don't talk about optimizing for any particular --

12 JUDGE KRATZ: You mean that he agrees they are not
13 explicitly described.

14 MR. RUSSETT: Agrees that they are not explicitly described,
15 that's right. That there is no mention in any of the references that -- I should,
16 I guess, qualify that.

17 There is no mention in any of the Yokoyama, Yoshioka or
18 Tachibana references of these properties and those references don't talk
19 about optimizing these properties. They don't even talk about the properties
20 at all.

21 So there is, I think, the general agreement, there is no
22 explicitness there.

23 During the prosecution, the appellants provided or proffered
24 evidence about a variety of resins and similar materials to show that the
25 examiner's general position that all resins, in essence, have these inherent
26 properties and it is a flawed proposition. That is simply something that

1 doesn't stand.

2 In addition to the materials that were cited during prosecution,
3 there is data in our application, example 1, comparative example 1, that
4 shows the references that resins have different properties. Clearly, they are
5 not inherent properties of all resins.

6 Similarly, even in the references cited by the examiner which
7 do disclose these properties, I'm thinking of the Tajima and European
8 reference, clearly, the cited materials there also don't share the properties
9 that the examiner says are inherent in other materials.

10 So the idea that you can make a general assertion that these
11 properties are inherent over a whole class of materials that just can't stand.

12 As we have cited, and I won't repeat to you, but in order to
13 establish an inherency rejection, you have to show that it's not just a
14 possibility or even a probability but is necessary that flows from the
15 materials of reference. Our view is that the examiner simply has not shown
16 that.

17 JUDGE GARRIS: The purpose of these properties in the
18 claimed invention is to reduce the possibility of warpage in the medium they
19 are claiming; isn't that correct?

20 MR. RUSSETT: That is correct.

21 JUDGE GARRIS: I bring that up because, with respect to
22 Yoshioka and Tachibana, the examiner makes the point that these
23 references, in addition to utilizing similar materials to the ones that you
24 disclosed for the protective layer, these references in addition seem to be
25 achieving the same goal that you seek to achieve in your claimed invention
26 and that is to reduce warpage to a particular level that is acceptable.

1 So with respect to particularly these two references, the
2 examiner has plural reasons for believing that these particular prior art
3 recording media inherently possess the values for the linear expansion
4 coefficient that you are claiming in your independent claims. How do you
5 respond?

6 MR. RUSSETT: The problem with that position is that the goal
7 of reducing warpage can unquestionably be achieved in different ways,
8 different materials perhaps, but different structures as well.

9 So a different combinations of layers which can be applied to
10 one side or another of the disk and, in fact, some of that is discussed in the
11 background section of our own present specification where various prior art
12 methods were attempting to reduce warpage are discussed.

13 The fact that a particular prior art reference may disclose a
14 material that's resistant to warpage says nothing about what the particular
15 properties are of the resins that were used since there are other ways that that
16 sort of result could potentially be achieved.

17 JUDGE GARRIS: So you are saying that in the case of
18 Yoshioka and Tachibana, they may achieve the same results that you
19 achieved but nevertheless may do so by way of characteristics other than the
20 linear expansion coefficient characteristic you recite in claim 10, for
21 example.

22 MR. RUSSETT: That is correct.

23 JUDGE GARRIS: How would we know whether in fact the
24 goals of these references are achieved by way of some characteristic other
25 that linear coefficients or, in fact, perhaps these references do indeed utilize
26 the same linear coefficient of expansion that you are claiming. How would

1 we know whether or not that is the case?

2 MR. RUSSETT: Well, certainly you could look to the structure
3 that is disclosed in those references in the way that the layers that they have
4 are arranged. I don't have at my fingertips exactly how that was done, but
5 evidence of differences in structure certainly would imply that inherent
6 properties --

7 JUDGE GARRIS: What difference in structure would there be
8 between claim 10 and these two references?

9 MR. RUSSETT: Well, if the references show, for example,
10 that they have multiple layers, perhaps arranged on opposite sides.

11 JUDGE GARRIS: I don't want you hypothesizing. I need for
12 you to point out exactly what in these references would distinguish your
13 claim from them.

14 In other words, what would make it clear that these references,
15 in fact, do not actually possess this linear expansion coefficient of claim 10.

16 MR. RUSSETT: I think I understand your question. I'm not
17 sure that I have that answer at my fingertips and I don't know whether in the
18 --

19 JUDGE GARRIS: Isn't that really the basis -- isn't that actually
20 the issue that we have before us? We need to know if the exemplified
21 embodiments of these references do or do not possess this linear expansion
22 coefficient that you are claiming.

23 MR. RUSSETT: That is --

24 JUDGE GARRIS: Now, we know they use similar materials
25 that you disclose using. We know they achieve the same results that you
26 disclose are achieved with your invention.

1 But what we don't know, what we can't tell, is whether the
2 specific linear expansion coefficient that is recited in claim 10 is, in fact,
3 possessed by the protective layer of these references. That's where we need
4 your help.

5 MR. RUSSETT: I would qualify my answer, I guess, by saying
6 that while I think that some of the other -- some of those references may
7 refer to decreasing warpage or other properties, whether they achieve that
8 same degree is achieved by the current invention. I'm not 100 percent sure
9 off the top of my head.

10 As I say, I understand your point, I think, and I wish I could
11 respond to it more fully. I need to reread the references and make sure that I
12 understood exactly what was disclosed in order to do that most effectively.

13 JUDGE GARRIS: In that case, maybe we should move on to
14 the 103 rejection that is based on Tajima.

15 MR. RUSSETT: So again, somewhat similar to the arguments
16 that the examiner has made previously, he recognizes that the properties of
17 the resins that are shown in the Tajima reference are not within the scope of
18 the present claims.

19 He appears to argue essentially that the Tajima reference could
20 have been optimized by selecting different values.

21 But he hasn't provided a clear rationale why optimizing any of
22 the many variables that are disclosed that Tajima refers to would be
23 sufficient to motivate one to make that or that you would have any
24 expectation that you could successfully balance the various properties in
25 such ways to arrive at a workable and practical optical storage material, at
26 least according to the present invention.

1 So he makes very broad assertions but nevertheless, I think the
2 selection of the particular combination of characteristics is not obvious to
3 what Tajima has to say.

4 JUDGE GARRIS: Why don't you be more specific and tell us
5 exactly what characteristic in claim 10 you believe would not have been
6 obvious based on Tajima.

7 MR. RUSSETT: I think that Tajima's materials do not show
8 the particular range of expansion coefficient that is recited by the present
9 claims.

10 In fact, the examiner has acknowledged that those are excluded.
11 Tajima provides a variety of different materials that have essentially the
12 same goals and yet they never use that particular -- they never selected
13 materials within the range of properties that are disclosed in the present case.
14 There is no evidence that they thought that that would work. There is no
15 obvious --

16 JUDGE GARRIS: If Tajima had, in fact, disclosed such a
17 thing, would it not then be a 102 reference against claim 10?

18 MR. RUSSETT: Very possibly it would be.

19 JUDGE GARRIS: Well the issue then is under 103, what in
20 claim 10 effectively distinguishes over the teachings of Tajima. In other
21 words, what in claim 10 would not have been obvious, based on these prior
22 art teachings.

23 MR. RUSSETT: And the appellant's position is the selection of
24 the particular values, the particular range of the expansion coefficients
25 would not have been obvious to Tajima.

26 JUDGE GARRIS: Let's look at that a little more closely then.

1 Please turn to page 5 of Tajima.

2 MR. RUSSETT: Page 5 of Tajima?

3 JUDGE GARRIS: That's correct. As you know, Tajima, like
4 you, is disclosing a data recording medium. Tajima wants, like you, to
5 reduce the tilt or the warpage of the medium and like you, Tajima is doing
6 so by balancing the opposing forces in such a way as to militate against
7 warpage.

8 If we look at paragraph 39 on page 5, you will see that Tajima
9 says in order to realize such an arrangement, the thickness, Young's
10 modulus, linear expansion coefficient of these various layers, including the
11 substrate, the thin film layer and the protecting film and then he says in
12 parentheses, particularly the protecting film, are set to their desired values.

13 So I think what the examiner's position is, is that one skilled in
14 the art, in light of this kind of teaching, would select a protective film having
15 a linear expansion coefficient that is effective for achieving the results that
16 Tajima and your clients would like to achieve.

17 His position, the examiner's position, is that it would have been
18 obvious to determine workable or optimum values for that linear coefficient
19 expansion characteristic and thereby achieve what is recited in your claim,
20 the same values as your claim recites.

21 So what in particular is the deficiency of that kind of reasoning?

22 MR. RUSSETT: I think that the, as I mentioned before, Tajima
23 is certainly working in the same area. If they had felt that this, that the
24 particular sorts of properties that had been selected according to the present
25 claims were important, then presumably they would have disclosed that or
26 they would have tested that in some way. I think the fact that --

1 JUDGE GARRIS: They did. They did test. They did disclose.
2 Now, they didn't specifically teach the exact values that you are reciting in
3 claim 10 but again, but again, that just means that it's not 102.

4 What we need to know is why are these values not obvious in
5 the face of the teachings of Tajima.

6 MR. RUSSETT: Certainly, my understanding is that the values
7 that are selected here provide you with better results. I don't know that I
8 have side-by-side data with Tajima to quantify that.

9 By choosing the values that we have in the present claims, we
10 achieve an optimized result. I wish I had that data at my fingertips again, so
11 that I could point to it, but I don't.

12 JUDGE GARRIS: Is there anything else you would care to
13 present as an argument before we end this?

14 MR. RUSSETT: Yes, please. I would like to point out that in
15 addition to what we have discussed of the independent claims, there are
16 some problems with some of the rejections of the dependent claims. I am
17 looking in particular at the dependent claims 11, 14, 20 and 21.

18 Each of those claims recites that the materials have a particular
19 selected coefficient expansion under humidity, in addition to the other
20 properties that we are discussing in reference to the other claims.

21 The examiner has never cited the Tajima reference, which is the
22 sole basis of the rejection of at least claims 20 and 21, has never cited the
23 Tajima reference as disclosing a coefficient of expansion.

24 In fact, the examiner has never mentioned or addressed this at
25 any time during prosecution with reference to Tajima. So those claims were
26 never particularly rejected for.

1 I think the only reference that is made in the examiner's answer
2 is that in section G, on one line, he says, and I'm not even sure whether it's
3 talking about this, but it says in reference to the dependent claims that the
4 properties are inherent.

5 That's the first time there has ever been any mention of that. So
6 it's hard to see how that could possibly be a valid rejection if it is never
7 addressed.

8 JUDGE GARRIS: The Tajima reference does talk about
9 preventing deformation caused by humidity changes, as your invention
10 likewise does; isn't that correct?

11 MR. RUSSETT: That is true. They do it in a different way.
12 The Tajima reference talks about changing the permeability of moisture
13 formation properties in different layers which is a different property from the
14 coefficient under expansion humidity.

15 So they discuss generally that there are problems related to
16 changes in humidity but there are potentially other solutions to changes
17 under humidity and there is no mention at all of selecting particular
18 coefficients of expansion under humidity.

19 So that rejection has never been made with any particularity on
20 the record at all and, again, I think the sole reference to it in regard to Tajima
21 and again, not even specifically to Tajima, was in the answer in that one line
22 on the section G of his answer.

23 JUDGE GARRIS: Very good. Let me ask Judge Kratz if he
24 has any questions you care to ask.

25 JUDGE KRATZ: I have no further questions.

26 JUDGE GARRIS: Judge Smith?

1 JUDGE SMITH: No, no questions.
2 JUDGE GARRIS: Mr. Russett, we have no further questions.
3 Thank you very much, sir, for coming in today and helping us with this case.
4 MR. RUSSETT: Thank you for your time.
5 Whereupon, the proceedings at 9:44 a.m. were concluded.
6